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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/059,611 04/13/98 AIHARA

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SAN JOSE CA 95113

EXAMINER

HAMDAN, W

ART UNIT

PAPER NUMBER

2776

DATE MAILED:

12/21/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/059,611

Applicant(s)
Tim Aihara et al.

Examiner
Wasseem H. Hamdan

Group Art Unit
2776



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☒ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2776

Part III - DETAILED ACTION

Information Disclosure Statement

1. Need to provide a copy of the prior art mentioned on the *Information Disclosure Statement* form page 2, item number R.

Claims

2. Claim 7, line 12, and claim 8 line 5 "g)" must be an "e)". Correction is required.

Claim Rejections - 35 USC § 103

3. This application currently names joint inventors. In considering patentability of the claims under 35 USC 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 USC 103(c) and potential 35 USC 102(f) or (g) prior art under 35 USC 103(a).

4. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

Art Unit: 2776

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molly E. Holzschlag (Laura Lemay Series Editor; Copyright 1997 by Sams.net Publishing) in view of Parulski et al. (US Patent Number 5,633,678).

With respect to independent claim 1:

Holzschlag disclose a method for generating an Internet page description file including images (page 75; column 1: lines 1-34; column 2: lines 19-34). Even though Holzschlag does not explicitly disclose that the image is captured by a digital imaging device having a display and a computer, it is obvious that the image used by Holzschlag teaching needs a digital imaging device having a display and a computer. However, Parulski et al. disclose the image is captured by a digital imaging device having a display and a computer (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the image captured by a digital imaging device, the digital imaging device having a display and a computer system in the system of Holzschlag .

The skilled person would have been motivated to modify Holzschlag 's system by including digital imaging device having a display and a computer because such modifications

Art Unit: 2776

would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

the method comprising the steps of:

a) providing the digital imaging device with a script comprising a set of program instructions (page 75 - column 1: lines 20-25)

b) executing the script to display interactive instructions on the display that prompt a user to perform specific operations (page 75 - column 1: lines 26-34);

c) in response to the user performing the specific operations, automatically updating the interactive instructions, such that the user is guided through a series of related image captures to obtain a series of resulting images (page 75 - column 1: lines 19-34; column 2: lines 20-34); and

d) generating an HTML (hypertext markup language) file including the resulting images, wherein the HTML file is formatted in accordance with a predefined model included in the script, such that a formatted HTML file is automatically generated by the digital imaging device (page 76 - column 1: lines 1-34).

With respect to dependent claim 2:

Holzschlag disclose the step of providing the directed image capture sequence by externally loading the program instructions into the digital imaging device (Page 76 - column 1: lines 1-34). Even though Holzschlag does not explicitly disclose the image digital imaging device,

Art Unit: 2776

it is obvious that the image used by Holzschlag teaching needs a digital imaging device. However, Parulski et al. disclose the digital imaging device (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the digital imaging device in the system of Holzschlag .

The skilled person would have been motivated to modify Holzschlag 's system by including digital imaging device because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40).

With respect to dependent claim 3:

Holzschlag discloses the claimed limitations as stated in claim 1 wherein step a) further includes the step of providing the program instructions as a text-based script (Page 75 - column 1: lines 20-34).

With respect to dependent claim 4:

Holzschlag discloses the claimed limitations as stated in claim 1 wherein step b) further includes the step of executing the script by the computer system interpreting the text-based script (Page 75 - column 1: lines 20-34).

With respect to dependent claim 5:

Art Unit: 2776

Holzschlag discloses the claimed limitations as stated in claim 1 step c) further includes the step of prompting the user for specific information, and entering the specific information on a text entry screen (page 75 - column 1: lines 25-34).

With respect to dependent claim 6:

Holzschlag discloses the claimed limitations as stated in claim 1 further including the step of displaying the interactive instructions on a translucent overlay bar (page 75 - column 1: lines 19-25; page 76 - Figure).

With respect to dependent claim 7:

Holzschlag discloses the claimed limitations as stated in claim 1. Even though Holzschlag does not explicitly disclose coupling the digital camera to the Internet, it is obvious that the image used by Holzschlag teaching needs a camera. However, Parulski et al. disclose the camera (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the camera in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including a camera because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40); and

Art Unit: 2776

f) making the HTML file available via the Internet by hosting a web server application on the computer system of the digital imaging device (page 76 - column 1: lines 23-30).

With respect to independent claim 8:

Holzschlag disclose a method for generating an Internet page description file including images (page 75; column 1: lines 1-34; column 2: lines 19-34). Even though Holzschlag does not explicitly disclose that the image is captured by a digital imaging device having a display and a computer, it is obvious that the image used by Holzschlag teaching needs a digital imaging device having a display and a computer. However, Parulski et al. disclose the image is captured by a digital imaging device having a display and a computer (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the image captured by a digital imaging device, the digital imaging device having a display and a computer system in the system of Holzschlag .

The skilled person would have been motivated to modify Holzschlag 's system by including digital imaging device having a display and a computer because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

the method comprising the steps of:

a) providing the digital imaging device with a script comprising a set of program instructions (page 75 - column 1: lines 20-25)

Art Unit: 2776

b) executing the script to display interactive instructions on the display that prompt a user to perform specific operations (page 75 - column 1: lines 26-34);

c) in response to the user performing the specific operations, automatically updating the interactive instructions, such that the user is guided through a series of related image captures to obtain a series of resulting images (page 75 - column 1: lines 19-34; column 2: lines 20-34); and

d) generating an HTML (hypertext markup language) file including the resulting images, wherein the HTML file is formatted in accordance with a predefined model included in the script, such that a formatted HTML file is automatically generated by the digital imaging device (page 76 - column 1: lines 1-34).

Even though Holzschlag does not explicitly disclose coupling the digital camera to the Internet, it is obvious that the image used by Holzschlag teaching needs a camera. However, Parulski et al. disclose the camera (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the camera in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including a camera because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40); and

f) making the Internet page description file available via the Internet by hosting a web server application on the computer system of the digital imaging device (page 75 - column 1: lines 19-25).

Art Unit: 2776

With respect to dependent claim 9:

Holzschlag discloses the claimed limitations as stated in claim 8. Even though Holzschlag does not explicitly disclose loading the program instructions into the digital imaging device, it is obvious that the image used by Holzschlag teaching needs a digital imaging device. However, Parulski et al. disclose the digital imaging device (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include loading the program instructions into the digital imaging device in the system of Holzschlag .

The skilled person would have been motivated to modify Holzschlag 's system by including digital imaging device because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40).

With respect to dependent claim 10:

Holzschlag discloses the claimed limitations as stated in claim 9 wherein step a) further includes the step of providing the program instructions as a text-based script (Page 75 - column 1: lines 20-34).

With respect to dependent claim 11:

Art Unit: 2776

Holzschlag discloses the claimed limitations as stated in claim 10 wherein step b) further includes the step of executing the script by the computer system interpreting the text-based script (Page 75 - column 1: lines 20-34).

With respect to dependent claim 12:

Holzschlag discloses the claimed limitations as stated in claim 11 step c) further includes the step of prompting the user for specific information, and entering the specific information on a text entry screen (page 75 - column 25-34).

With respect to dependent claim 13:

Holzschlag discloses the claimed limitations as stated in claim 12 wherein the Internet page description file is a hypertext markup language file (page 76 - column 1: lines 23-30).

With respect to independent claim 14:

Holzschlag disclose a system for generating a formatted document including text and images (page 75; column 1: lines 1-34; column 2: lines 19-34). Even though Holzschlag does not explicitly disclose a hand held digital imaging device including a computer system and a display, it is obvious that the image used by Holzschlag teaching needs a digital imaging device having a display and a computer. However, Parulski et al. disclose a hand held digital imaging device including a computer system and a display (Abstract; Fig. 1; column 2: lines 51-65)

Art Unit: 2776

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include a hand held digital imaging device including a computer system and a display in the system of Holzschlag .

The skilled person would have been motivated to modify Holzschlag 's system by including hand held digital imaging device including a computer system and a display because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

a) display interactive instructions on the display that prompt a user to perform specific operations (page 75 - column 1: lines 20-25);

b) in response to the user performing the specific operations, automatically updating the interactive instructions, such that the user is guided through a sequence of the interactive instructions adapted to capture information from the user (page 75 - column 1: lines 20-34);

d) transferring the information captured from the user to a formatted document, wherein the formatted document is formatted in accordance with a predefined model included in the script (page 75 - column 1: lines 20-34), Even though Holzschlag does not explicitly disclose such that the formatted document is automatically generated by the digital imaging device, it is obvious that the image used by Holzschlag teaching needs a digital imaging device having a display and a computer to format the document. However, Parulski et al. disclose a such that the formatted document is automatically generated by the digital imaging device (Abstract; Fig. 1; column 2: lines 51-65)

Art Unit: 2776

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include formatted documenting is automatically generated by the digital imaging device in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including the formatted document which is automatically generated by the digital imaging device because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

With respect to dependent claim 15:

Holzschlag discloses the claimed limitations as stated in claim 14 wherein step a) further includes providing a sequence of interactive instructions for a directed image capture, wherein the script prompts the user through a series of related image captures resulting in a plurality of stored images (page 75 - column 1: lines 19-25; page 76 - Figure). Again the rationale behind capture an image is explained in claim 14.

With respect to dependent claim 16:

Holzschlag discloses the claimed limitations as stated in claim 14 wherein step a) further includes the step of providing the program instructions as a text-based script (Page 75 - column 1: lines 20-34). Even though Holzschlag does not explicitly disclose digital camera, it is obvious

Art Unit: 2776

that the image used by Holzschlag teaching needs a digital camera. However, Parulski et al. disclose a digital camera (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include digital camera in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including digital camera because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

With respect to dependent claim 17:

Holzschlag discloses the claimed limitations as stated in claim 14, wherein the predefined model comprises a set of programming instructions which determine the formatted appearance of the document (page 75 - column 1: lines 19-34; page 76 - Figure).

With respect to dependent claim 18:

Holzschlag discloses the claimed limitations as stated in claim 17, wherein the predefined model is predefined in accordance with a particular purpose of the script such that the formatted document has an appearance in accordance with the particular purpose (page 75 - column 1: lines 19-34; column 2: lines 20-34; page 76 - column 1: lines 1-34).

With respect to dependent claim 19:

Art Unit: 2776

Holzschlag discloses the claimed limitations as stated in claim 14, wherein the document is an Internet page description file which defines a web page (page 75 - column 1: lines 19-34; column 2: lines 20-34; page 76 - column 1: lines 1-34).

With respect to dependent claim 20:

Holzschlag discloses the claimed limitations as stated in claim 19. Even though Holzschlag does not explicitly disclose coupling the digital camera to the Internet, it is obvious that the image used by Holzschlag teaching needs a camera. However, Parulski et al. disclose the camera (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the camera in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including a camera because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40); and

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A Guide to Sizzling WEB site Design to Molly E. Holzschlag (Laura Lemay Series Editor; Copyright 1997 by Sams.net Publishing).

Art Unit: 2776

U.S. Patent Number 5,721,9089 to Ferguson.

U.S. Patent Number 5,721,908 to Lagarde et al.

U.S. Patent Number 5,659,729 to Nielsen.

U.S. Patent Number 5,898,833 to Kidder.

U.S. Patent Number 5,640,193 to Wellner.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem Hamdan whose telephone number is (703) 305-3968. The examiner can normally be reached Monday-Thursday from 700AM-400PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on (703) 305-4713.

The fax phone number for this Art Unit is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Receptionist at (703) 305-3800.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Art Unit: 2776

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry, please label

"FORMAL" and sign as attorney of record)

Or:

(703) 305-9724 (for informal or draft communications, please label "PROPOSED"


or "DRAFT" and prominently label PLEASE DELIVER DIRECTLY TO

EXAMINER)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Wasseem H. Hamdan

WH
December 16, 1999


STEPHEN S. HONG
PRIMARY EXAMINER